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ml

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/846,108 04/25/97 KIM

K

EXAMINER

LM12/0816

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AOKI, M

ART UNIT	PAPER NUMBER
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2745

DATE MAILED:

08/16/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/846,108

Applicant(s)
Kim

Examiner
Makoto Aoki

Group Art Unit
2745



☒ Responsive to communication(s) filed on May 21, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 7, 9, 11-13, 17, 18, 20, and 21 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 7, 9, 11-13, 17, 18, 20, and 21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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OFFICE ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Response to Arguments

2. Applicant's arguments filed 2/17/99 have been fully considered but they are not persuasive.

3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing an internal power source in an alarm system,) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to **claims 7, 11, 12 and 13**, the Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by suggesting that the Alpert reference does not disclose an internal power source. It is noted, however, that claims 7, 11, 12 and 13, as

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originally filed, do not claim this feature. It would appear, therefore, that the 35 USC 103 rejections based on the Alpert and Dounies references, as set forth in an earlier Office action, are proper.

Hence, the Examiner is not persuaded by the Applicant's arguments.

4. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to claims 7, 11, 12 an 13, the Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by suggesting that the Alpert reference does not provide the "internal power source" set forth in the amended claims. However, the Examiner did not and does not rely on the Alpert reference to meet this limitation in formulating the 35 USC 103 rejection. (See 35 USC 103 section hereinbelow in this Office action.)

Hence, the Examiner is not persuaded by the Applicant's arguments.

5. Applicant's arguments do not comply with 37 CFR 1.111© because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

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As to **claim 7**, the Applicant attempts to overcome the 35 USC 103 rejection based on at least the Alpert and Dounies references by suggesting that the Alpert reference does not disclose an image storage memory and without providing further evidence, attempts to support this statement by affirming that "this conclusion confirmed by being applicant's comments." Demonstrating that one's own conclusions are one's own comments does not amount to a convincing argument.

Hence, the Examiner is not persuaded by the Applicant's arguments.

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing an image storage device in an alarm system,) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to **claim 7**, assuming, *in arguendo*, that it is the Examiner's comments in an earlier Office action that supports the Applicant's suggestion that the Alpert reference does not disclose an image storage memory, it is noted that the Examiner did not rely on the Alpert reference to teach this feature, but relied instead on the Dounies reference to this feature.

Hence, the Examiner is not persuaded by the Applicant's arguments.

7. In response to applicant's argument that is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent

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to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, the Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by suggesting that the Dounies reference requires a phone jack and an AC power source with a battery backup. However, both the Alpert and Dounies references are in the same field of endeavor as the Applicant, namely, telephonic emergency communications, and together provide the teachings that would have suggested the claimed inventions to those of ordinary skill in the art, as discussed under the 35 USC 103 section below. Demonstrating that the Dounies reference by itself discloses features not set forth in the Applicant's open-ended claims does not appear to overcome the 35 USC 103 rejections based on a combination of Alpert and Dounies.

Hence, the Examiner is not persuaded by the Applicant's arguments.

8. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by suggesting that Dounies provides an external memory means. The Examiner, however, relied on the Alpert reference to teach providing memory and alarm system in

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side a common housing, as claimed. Furthermore, providing a common housing to house all components of a portable communication system would appear to be a matter of common knowledge, and therefore clearly obvious to one skilled in the art.

Hence, the Examiner is not persuaded by the Applicant's arguments.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by stating that "examiner has determined that the combination of Alpert and Dounies reference does not disclose the concept of pressing the emergency key once to send an alarm signal and pressing it a second time to send audio and image signals." The Examiner, however, did not rely on the Alpert and Dounies references alone in meeting this claim limitation. Instead, the Examiner took Official notice of well-known and expected concepts in the art, in combination with teaching in the Alpert and Dounies reference to demonstrate that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a device with said limitation. It

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should be emphasized that the Applicant does not appear to have fully addressed the Examiner's grounds for rejection, as set forth in an earlier Office action.

Hence, the Examiner is not persuaded by the Applicant's arguments.

10. As to **claims 11 and 12 and 17-19**, the Applicant relies upon the alleged allowability of claims 7 in attempting to overcome the 35 USC 103 rejections. For the same reasons as for claim 7 as discussed hereinabove, the Examiner is not persuaded by applicant's arguments.

As to **claim 13**, the Applicant relies upon the alleged allowability of claims 7 and 12 in attempting to overcome the 35 USC 103 rejections. For the same reasons as for claims 7 and 12 as discussed hereinabove, the Examiner is not persuaded by applicant's arguments.

Hence, the Examiner is not persuaded by Applicant's arguments.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Applicant attempts to overcome the 35 USC 103 rejections based on at least the Alpert and Dounies references by suggesting that there is no motivation to combine. As discussed

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previously hereinabove, however, both references are in the same field of endeavor as the present application, namely telephonic emergency communications, and together provide the teachings that would suggest the claimed inventions to one skilled in the art. Furthermore, the Examiner provided a motivation for combining in every instance when a teaching from one source was combined with a teaching from another source, as is clearly evidenced by the 35 USC 103 rejections.

Hence, the Examiner is not persuaded by the Applicant's arguments.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 7, 9, 11-13 and 20-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (U.S. Patent Number 5,742,666) in view of Dounies (U.S. Patent Number 5,343,509.)

As to **claims 7 and 9**, Alpert discloses an emergency cellular mobile telephone (title and abstract,) with a radio transceiver (54, figure 3A, lines 23-26, column 6.) Alpert's cellular telephone

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also comprises an alarm mechanism (control unit 70, figure 3A,) which automatically places a distress call and sends a recorded audio message when an emergency is detected (abstract,) by external sensors (detectors 66 and 66a-66d, figure 3A.) Alpert's system also comprises a memory for storing audio signals (non-volatile memory 91, figure 3A, and lines 61, column 7 through line 6, column 8.) As can be seen from figures 2 and 3A, the memory (91, figure 3A,) and the alarm system (control unit 70,) are housed in the same housing as the radio transceiver (54, figures 2 and 3A.) It is noted that all radio transceivers inherently comprise both a radio transmitter and a radio receiver, by definition, as is well understood in the art.

Alpert's system, however, fails to provide a memory for storing images. In an analogous art, however, Dounies discloses an emergency communication device which auto-dials a distress call (lines 25-26, column 3.) Dounies teaches that audio communication may be too slow and inaccurate in emergency situations (lines 32-34, column 1,) and discloses sending image information captured by a digital camera (36, figure 2, line 20, column 5,) and stored in memory instead (lines 1-4 and 30-33, column 8.)

Hence, it would have been obvious to one of ordinary skill in the art to provide a memory which can store images, in the device disclosed by Alpert, in order to communicate the distress call more quickly and accurately, as taught by Dounies.

The Alpert and Dounies references are combinable because they are in the same field of endeavor as the present application: automatically sending stored information by telephone to a remote location in case of an emergency.

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As to **claim 11**, Alpert and Dounies disclose everything claimed, as respectively applied above to claims 1 and 7. Dounies further discloses an AC power supply with backup batteries (power supply 35, figure 4B, lines 2-7, column 6,) As can be seen from figures 4A and 4B, the power supply in Dounies's invention supplies power to the alarm (alarm 31, figure 4A, the audio and video memory (message ROM 23, and photo memory 37, figure 4B.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide batteries to power the alarm, the audio and image memory, as suggested by Dounies, in the above combination of Alpert and Dounies, in order to provide a backup power source.

The above combination of Alpert and Dounies fails to disclose a battery which supplies power to the radio receiver and which is associated with the housing. However, Official Notice is taken that the concept and advantages of providing a battery to supply power to a portable radio device, and the technique of providing a battery inside the housing of a portable device are well known and expected in the art. Since Alpert discloses his invention as being a portable cellular telephone (lines 36-44, column 4,) it would have been obvious to one of ordinary skill at the time of the invention to provide power to the radio receiver in the above combination of Alpert and Dounies from a battery associated with the housing, as is expected in the art, so that the portable device can function without having to make a connection to an external power source.

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As to **claims 12**, Alpert and Dounies discloses everything claimed, as applied above to claim 1. As illustrated in figure 2, Alpert further discloses a keypad (62, figure 2,) and an emergency key (64, figure 2,) which triggers an automatic distress call and sends stored information (lines 28-49, column 6,) and also suggests that a key on the keypad can be used instead of a dedicated emergency key (lines 50-54, column 6.) Alpert also teaches that an emergency auto-dial key is useful in case the caller is injured (lines 1024 and 41-54, column 2.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide a key associated with a keypad which triggers an alarm signal and sends stored audio and video information, as suggested by Alpert, in the above combination of Alpert and Dounies, in order to automatically send a detailed alarm message in emergency in case the user is injured.

The above combination of Alpert and Dounies fails to disclose pressing the emergency key once to send an alarm signal, and pressing it again to send audio and image signals. Dounies, however, teaches pressing a first switch (switch 3, figure 2,) to send an alarm signal to a remote location (lines 14-22, column 6,) and optionally pressing a second switch (switch 4, figure 2,) to send additional stored information as required, depending on the nature of the emergency (lines 26-41, column 6.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide a first key to send an alarm to a remote location, and a second key to send audio and image signals, as suggested by Dounies, in the above combination of Alpert and Dounies, in order to be able to send additional information as required by the nature of the emergency.

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The above combination of Alpert and Dounies fails to provide pressing a key once to send an alarm, and pressing the same key a second time to send additional audio and video information. However, Official Notice is taken that the concept and advantages of providing multi-purpose keys on a portable device are well known and expected in the art.

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide pressing a key once to send an alarm, and pressing the same key a second time to send additional audio and video information, as is expected in the art, in the above combination of Alpert and Dounies, in order to reduce the size and weight of the portable device by limiting the number of keys required.

As to **claim 13**, Alpert and Dounies disclose everything claimed, as applied above to claim 12. Dounies further discloses auto-dialing when the emergency button is activated and transmitting an alarm to a remote location (lines 34-46, column 2,) and teaches that his invention improves upon the prior art by providing complete and correct information more quickly in an emergency situation (lines 13-38, column 1.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide an automatic dialer which is activated when the emergency key is pressed whereby an alarm is generated for transmission to the remote location, as taught by Dounies, in the above combination of Alpert and Dounies, in order to quickly provide complete and correct information in an emergency situation.

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As to **claims 20-23**, Alpert and Douines disclose everything claimed, as applied above to claim 11. Official notice is taken that the concept and advantages of mounting device components to a housing in a portable communication system are well known and expected in the art. Furthermore, Official notice is also taken that the concept and advantages of providing a single battery to power a cellular telephone is also well known and expected in the art.

Hence, it would have been obvious to one of ordinary skill in the art at the time of the invention to mount the alarm system and the radio in the above combination of Alpert and Dounies, in order to prevent the components from rattling around in the housing, and to provide a single battery for powering the cellular phone and the storage means in the above combination of Alpert and Dounies, simplify battery replacement.

14. **Claims 17 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (U.S. Patent Number 5,742,666) in view of Dounies (U.S. Patent Number 5,343,509) and Hashimoto et al. (U.S. Patent Number 5,815,201.)

As to **claim 17**, Alpert and Dounies disclose everything claimed, as applied above to claim 7, but fail to provide means for enabling stored audio and image signals to be detected by an external device. In an analogous art, however, Hashimoto et al. disclose a digital camera (title,) which stores both audio and video data in memory (abstract.) According to Hashimoto's invention, stored audio

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and video signals are sent to an external device (lines 29-35, column 1) and teaches that by sending both the audio and video signals together, the external device can determine that the two signals are related to each other (lines 27-30, column 2.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide means for enabling the stored audio and image signals to be detected by an external device, as taught by Hashimoto, in the digital camera in the above combination of Alpert and Dounies, so that the external device can determine that the audio and image signals are related to each other.

As to **claim 19**, Alpert and Dounies disclose everything claimed, as applied above to claim 7, but fail to provide a receptacle for enabling a television or a personal computer to be connected so that stored images can be viewed. In an analogous art, however, Hashimoto teaches attaching an external device to monitor the audio and image data (lines 29-35, column 1,) and suggests that a personal computer can be used as an external monitoring device (lines 6-29, column 2.) Hashimoto further discloses a connector on the housing for connecting an external video display and audio device (164, figure 1B, and lines 47-50, column 4.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide a connector enabling the external connection of a personal computer, in the above combination of Alpert and Dounies, so that the stored images can be viewed on the computer as suggested by Hashimoto.

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The above combination of Alpert, Dounies and Hashimoto, however, fails to provide a an external audio/video connector which is a receptacle. However, interface standards for connecting DTEs to DCEs, such as EIA/TIA RS-232 D-type connectors, for instance, are well known in the art to provide electrical connectors with pins and matching receptacles.

Since RS-232 provides for receptacles at the DCE end, it would have been obvious at the time of the invention to provide an RS-232 D-type connector with receptacles at the cellular telephone side, for connecting the cellular telephone to a personal computer, in the above combination of Alpert, Dounies and Hashimoto, in order to be able to use a standard cable between the cell phone and the personal computer.

15. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (U.S. Patent Number 5,742,666) in view of Dounies (U.S. Patent Number 5,343,509) and Maeda (U.S. Patent Number 5,740,543.)

As to **claim 18**, Alpert and Dounies disclose everything claimed, as applied above to claim 7, but fail to provide a means for recording conversations between the cellular phone and another. In an analogous art, however, Maeda teaches recording a conversation in the memory of cellular phone when the cell phone user is not able take notes (lines 8-31, column 1.)

Hence, it would have been obvious to one of ordinary skill at the time of the invention to provide a storing means which enables the telephone conversation between the cellular phone user

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and another to be recorded, as taught by Maeda, in the above combination of Alpert and Dounies, in case the cell phone user is not able to take notes by hand.

Conclusion

16. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Makoto Aoki whose telephone number is (703) 308-9640. The examiner can normally be reached Monday through Friday from 8:00 am to 5:00 pm, except on the first Friday of the Federal bi-weekly pay period.

Serial Number: 08/846,108

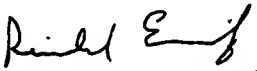
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reinhard Eisenzopf, can be reached on (703) 305-4711. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Makoto Aoki
August 4, 1999

 8-14-99
REINHARD J. EISENZOPF
SUPERVISORY PATENT EXAMINER
GROUP 2700